Appl. No. 10/672,184
Notice of Appeal dated February 26, 2008
Reply to Advisory Action of February 8, 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Eduard K. de Jong
Assignee:	Sun Microsystems, Inc.
Title:	RENDERING AND ENCRYPTION ENGINE FOR APPLICATION PROGRAM OBFUSCATION
Serial No.:	10/672,184 Filed: September 25, 2003
Examiner:	Ponnoreay Pich Group Art Unit: 2135
Docket No.:	SUN040027

Monterey, CA
February 26, 2008

Mail Stop AF
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Advisory Action dated February 8, 2008, Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below.

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While the standard for combination of references in a prima facie obviousness rejection has been broadened by *KSR International Co. v. Teleflex Inc.*, the MPEP includes specific criteria that must be met for a combination to establish a prima facie obviousness rejection. As demonstrated below, these requirements have not been met and so a prima facie obviousness rejection has not been made. (See second complete paragraph on pg. 3 of the paper dated January 24, 2008)

The MPEP requires that the references and the claims be considered as a whole. *"A prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention. "* (Emphasis in original) MPEP § 2141.02 VI., 8th Ed., Rev. 6, pg. 2100-126, (Sept. 2007). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious." MPEP § 2141.02 I., 8th Ed., Rev. 6, pg. 2100-123, (Sept. 2007).

The primary reference, U.S. Patent No. 7,170,999, hereinafter referred to as Kessler, teaches two different processes—one process is directed at providing a client with the tools necessary to perform a secure peer-to-peer file transfer (Paper dated January 24, 2008, pg. 4) and the other process is the operations in the peer-to-peer file transfer (Paper dated January 24, 2008, pg. 5, last paragraph).

The tools provided to the client are a public key, a secret key, encryption and decryption algorithms, and obfuscation and deobfuscation algorithms. (Paper dated January 24, 2008, pg. 4, last quoted paragraph) Kessler, taken as a whole, is dependent upon each client having this same set of tools so that any one client can transfer file via a peer-to-peer network to any other client. Kessler also makes clear that each client is given this same set of tools, which Kessler

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refers to as "proprietary client software." (Paper dated January 24, 2008, pg. 4, first three quoted paragraphs. See also, paper dated Sept. 13, 2007, pg 33, quoted paragraph.)

Next, Kessler considered file and key transfer associated with a peer-to-peer file transfer. The public keys were transferred directly between clients without either encryption or obfuscation. Kessler, Col. 7, lines 51 to 65. It is only the file being transferred and a key TK that are taught as being encrypted. Kessler expressly considered encryption and obfuscation and taught that only the file was obfuscated and encrypted. (Kessler, Col. 8 at lines 59 and 60. See also, paper dated Sept. 13, 2007, pg 33, first full paragraph.) The key TK is only encrypted using a public key and is not obfuscated. Kessler, Col. 8 at lines 59 and 60. The encryption is the standard public key, private key encryption.

The rejection ignores the distinction in the two processes taught by Kessler. The final rejection at page 7 cites to the proprietary client software as suggesting the first two elements of Claim 1 and the secret key (SK2) of the user providing the file in the peer-to-peer file transfer along with key TK. Secret key (SK2) is identified as the first key in Claim 1 ("the first decryption key, i.e., SK2) and key TK is the second key.

The rejection then becomes totally confused and changes the definitions. In the second paragraph on page 7, the public key PK2 and key TK are cited as the first and second keys. Thus, the first key shifts from second user secret key SK2 in the first paragraph of the rejection to second user public key PK2 in the second paragraph.

If the first key is SK2, Kessler fails to teach or suggest that user 1 receives a reference to both (1) a decryption algorithm that performs the decryption algorithm for second user secret key SK2 and (2) key SK2. Kessler expressly teaches away from this interpretation. If the first key is PK2,

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similar Kessler fails to teach or suggest that user 1 receives the decryption algorithm for key PK2 and key PK2. As noted above, Kessler taught that the public keys were traded without encryption and so there is no need for a decryption algorithm for key PK2.

Thus, the rejection simply reduces the claim limitations to a gist and also ignores the express teaching of Kessler as a whole. This error alone is sufficient to overcome the rejection.

Further, the rejection mischaracterizes the teaching with respect to key TK. Key TK is not used in decrypting, encrypting, obfuscating or deobfuscating anything in the proprietary client software. Key TK is used only in the peer-to-peer file transfer and was expressly taught as only being encrypted and not obfuscated. Thus, Kessler, taken as a whole, teaches away from obfuscating key TK, which the rejection cited as the second key. This also is sufficient to overcome the rejection.

Next, the rejection ignores the order and relationships of Kessler taken as a whole and goes to three other references to selectively modify Kessler. First, the rejection throws away the public-private key pairs of Kessler and uses a session of key of Okada, U.S. Patent No. 6,789,177. (See Final Rejection, pg. 8) This completely changes the principles of operation of Kessler as a session key would not be suitable for use in the "proprietary software package provided to each client," by Kessler as the same session key, as defined by Okada, would not be available to both users and even if it was, such a key would not help to differentiate between users as in the key pairs used by Kessler. Therefore, the proposed modification changes the principles of operation of Kessler. According to the MPEP,

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

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MPEP §2143.01 VI., 8th Ed., Rev. 6, pg. 2100-141, (Sept. 2007). Thus, not only was the reference not considered as a whole, but also the modifications necessary to make the reference applicable to Applicant's claims change the principles of operation of Kessler and so according to the MPEP a prima facie obviousness rejection has not been made.

The rejection goes on and uses one reference, Levine, to modify another reference, Shenn Orr, and then inserts the modified Shenn Orr back into Kessler. Again, Kessler taught that the same obfuscation and deobfuscation programs were provided to each client. Accordingly, modifying Kessler so that the obfuscated program depended on a target ID would mean that different clients received different programs. The package provided by Kessler, except for the public and private keys, is independent of the client and such a package is necessary to facilitate the peer-to-peer file transfers with the files obfuscated. Thus, the rejection yet again changes the principles of operation of Kessler. The MPEP is unambiguous as quoted above that this means that a prima facie obviousness rejection has not been made.

In addition, both of these modifications are such that after the proposed modifications, Kessler would not work, because the modifications remove features that Kessler taught were necessary for the peer-to-peer file transfers. See paper dated January 24 at the paragraph starting at the end of page 7 and continuing onto page 8).

When the primary reference and the claims are considered as required by the MPEP, the MPEP indicates "the teachings of the references are not sufficient to render the claims prima facie obvious." Accordingly, all claims are in condition for allowance.
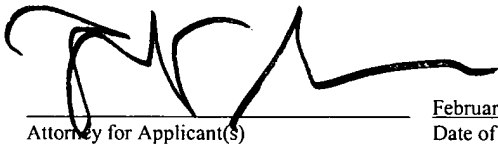
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For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 26, 2008.

_____ February 26, 2008
Attorney for Applicant(s) Date of Signature

Respectfully submitted,

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